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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,134	10/15/2001	Bradford Evan Gliner	337348021US	4196
25096	7590	10/21/2005	EXAMINER	
PERKINS COIE LLP			BRADFORD, RODERICK D	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			PAPER NUMBER	
SEATTLE, WA 98111-1247			3762	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/978,134	<b>Applicant(s)</b> GLINER ET AL.
	<b>Examiner</b> Roderick Bradford	<b>Art Unit</b> 3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-31 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-31 and 50-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/25/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed July 25, 2005 have been fully considered but they are not persuasive. The Saberski reference still reads on claims 16-19, 30 and 31 since in column 5, lines 60-62 states that stimulation can be provided to the spinal cord, which is part of the central nervous system. Therefore the rejection stands.

### ***Information Disclosure Statement***

2. The information disclosure statement filed July 25, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because three documents under the non patent literature documents do not have dates. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16-19, 30, 31, 50, 51, and 53-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Saberski U.S. Patent No. 6,725,094.

Referring to claims 16 and 53 Saberski discloses a method of automatically determining a favorable neuro-stimulation program for a patient comprising: applying an electrical stimulus having a plurality of stimulus parameters to a selected configuration of the therapy electrodes that have been installed at a target site; sensing a response to the applied electrical stimulus at a sensing device that has been installed at a sense location; determining whether the response is within a desired range or an improvement over a previous sensed response from a different electrical stimulus and/or a different configuration of therapy electrodes; selecting an alternate configuration of electrodes and/or an alternate electrical stimulus, wherein the selecting procedure comprises computing an alternate stimulus parameter while maintaining a constant electrode configuration, and wherein computing the alternate stimulus parameter comprises correlating a plurality of different stimuli applied to the constant electrode configuration with corresponding sensed responses to determine a stimulus/response trend and estimating a new stimulus parameter that is expected to improve efficacy according to the stimulus/response trend; repeating the applying; sensing and determining procedures using an alternate configuration of electrodes

and/or the alternate electrical stimulus and choosing a configuration of therapy electrodes and/or an electrical stimulus corresponding to a sensed response that is within a desired range and/or provides a better result compared to others (column 3 line 65 – column 4 line 29).

Referring to claim 17, wherein the selecting procedure comprises computing an alternate electrode configuration while maintaining constant stimulus parameters, and wherein the computing the alternate electrode configuration comprises correlating a plurality of sensed responses with corresponding electrode configurations to which the constant stimulus parameters were applied to determine and electrode-configuration/response trend to estimating a new electrode configuration that is expected to improve efficacy according to the electrode-configuration/response trend (column 4, lines 29-31).

Referring to claim 30, wherein the data comprises coordinates of neural activity relative to the therapy electrodes (column 12, lines 23-30).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saberski et al. U.S. Patent No. 6,725,094.

Referring to claims 20-27 Saberski discloses the claimed invention except for the specified times as stated by applicant. It would have been an obvious matter of design choice to one skilled in the art to modify the teachings of Saberski to include the different specified times, since applicant has not disclosed that the specified times provides any criticality and/or unexpected results and it appears that the invention would perform equally well with any specified time, such as the time as used by Saberski, as a means for configuring the electrodes to provide appropriate stimulation.

8. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saberski et al. U.S. Patent No. 6,725,094 in view of John et al. U.S. Patent No. 6,463,328.

Referring to claims 28 and 29, Saberski fails to disclose wherein the sensing procedure comprises attaching EMG sensors to a sense site of the patient, detecting peripheral responses to the stimuli applied to the electrodes, and automatically sending the detected peripheral responses to the controller and wherein the sensing procedure comprises detecting data related to neural activity using a functional MRI and

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automatically sending the data to the controller. However, John discloses attaching EMG sensors to a sense site of the patient, detecting peripheral responses to the stimuli applied to the electrodes, and automatically sending the detected peripheral responses to the controller (column 4 line 59 – column 5 line 40) and wherein the sensing procedure comprises detecting data related to neural activity using a functional MRI and automatically sending the data to the controller (column 6, lines 7-26 and 48-54) as a more efficient means for obtaining data.

It would have be obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Saberski to include attaching EMG sensors to a sense site of the patient, detecting peripheral responses to the stimuli applied to the electrodes, and automatically sending the detected peripheral responses to the controller and wherein the sensing procedure comprises detecting data related to neural activity using a functional MRI and automatically sending the data to the controller, as taught by John, as a more efficient means for obtaining data.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (571) 272-4942. The examiner can normally be reached on Monday - Friday 9 a.m. - 6:30 p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*R. Bradford*  
R.B.

*u*  
GEORGE R. EVANISKO  
PRIMARY EXAMINER

10/17/5